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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,565	06/05/2000	Yoshinori Miyazawa	1046.1214/JDH	7602
21171	7590	07/05/2006	EXAMINER	
STAAS & HALSEY LLP JIM LIVINGSTON SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGUYEN, DUSTIN	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/587,565	Applicant(s) MIYAZAWA, YOSHINORI	
	Examiner Dustin Nguyen	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 4-8, 10-14, 16-20 are presented for examination.

Response to Arguments

2. Applicant's arguments filed 03/29/2006 have been fully considered but they are not persuasive.
3. As per remarks, Applicants' argued that (1) Hara does not teach or suggest determining whether a reply destination of the electronic mail is part of a mailing list having multiple destination address".
4. As to point (1), Hara discloses a content of a response [i.e. reply] to a received electronic mail message should be informed to the transmission destinations of the global address communications, the global address communication function by which an electronic mail is transmitted to a plurality of transmission destinations in a batch mode [i.e. mailing list having multiple destination addresses] [col 1, lines 46-49; and col 3, lines 61-col 4, lines 8].
5. As per remarks, Applicants' argued that (2) Hara does not specifically disclose or suggest "selecting" therefrom for transmitting "only to the at least one destination address in the mailing list based on said selecting".

6. As to point (2), Hara discloses a selection apparatus [14, Figure 1; and col 6, lines 33-41] for selecting a final transmission destination mail address from said transmission destination candidate mail addresses [col 8, lines 25-31] and the transmission destinations of the global address communications are outputted as the transmission destination candidates and the user can readily transmit the electronic mail by merely selecting this desired transmission destination from these outputted transmission destination candidates [i.e. selecting ... for transmitting only to the at least one destination address in the mailing list based on said selecting] [col 4, lines 8-11].

7. As per remarks, Applicants' argued that (3) the cited references do not teach " a display unit which displays, when visibly displaying all the extracted mail addresses as the reply destination candidates, the name of the mail address extracted from the text of the received E-mail and unregistered in the mail address book as the name unknown in the format of corresponding to the mail address" as recited in claim 6.

8. As to point (3), it is rejected for similar reasons as stated in previous Office Action. Furthermore, Hara discloses the output apparatus for displaying the extracted transmission destination candidate addresses [i.e. visibly displaying all the extracted mail addresses] [13, Figure 1; Figure 4; col 6, lines 26-41; and col 10, lines 7-10].

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by Hara [US Patent No 5,938,725].

10. As per claim 20, Hara discloses the invention substantially as claimed including a method of transmitting an electronic mail [i.e. determining an address of a transmission destination for an electronic mail message] [Abstract; and col 1, lines 9-15], comprising:

determining whether a reply destination of the electronic mail is part of a mailing list having multiple destination addresses listed therein [i.e. a content of a response [i.e. reply] to a received electronic mail message should be informed to the transmission destinations of the global address communications, in which an electronic mail is transmitted to a plurality of transmission destinations in a batch mode] [col 1, lines 46-49; and col 3, lines 61-col 4, lines 8]; and

selecting at least one destination address from the multiple destination addresses in the mailing list and transmitting the electronic mail only to the at least one destination address in the mailing list based on said selecting [i.e. the transmission destinations of the global address communications are outputted as the transmission destination candidates and the user can readily transmit the electronic mail by merely selecting this desired transmission destination from these outputted transmission destination candidates] [14, Figure 1; col 4, lines 8-11; and col 8, lines 25-31].

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 4, 7, 8, 10, 13, 14, 16 and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara [US Patent No 5,938,725], in view of Weber et al. [US Patent No 5,878,230].

13. As per claim 1, Hara discloses the invention substantially as claimed including an E-mail terminal device comprising:

a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time by a predetermined single mail address [col 2, lines 64-67; col 3, lines 51-60; and col 4, lines 48-56];

a selecting unit which displays the at least one extracted mail address as a candidate for a reply destination from which a specified reply destination can be selected [col 3, lines 14-28; and col 4, lines 2-11].

Hara does not specifically disclose

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an extracting unit which automatically extracts at least one mail address contained in a text of the E-mail received when the reply destination mail address is the address of the mailing list, and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list.

Weber discloses

an extracting unit which automatically extracts at least one mail address contained in a text of the E-mail received when the reply destination mail address is the address of the mailing list [i.e. if the IDP indicates third party addressing, then the system automatically updates the IDP with the third party addresses] [86, Figure 6; and col 5, lines 18-23], and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list [i.e. if the IDP does not indicate third party addressing] [84, Figure 6; and col 5, lines 4-18].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Weber because Weber's teaching would allow to reply to destination correctly without error.

14. As per claim 2, Hara discloses the invention substantially as claimed including an E-mail terminal device comprising:

a first extracting unit which automatically extracts a reply destination mail address from a mail header of an E-mail received [Figure 4; col 2, lines 64-67; and col 6, lines 18-26];

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a selecting unit which displays all the extracted mail addresses as candidates for reply destinations from which a specified reply destination can be selected [col 3, lines 1-3; and col 6, lines 29-40];

a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time by a predetermined single mail address [col 2, lines 64-67; col 3, lines 51-60; and col 4, lines 48-56];

the second extracting unit, when the reply destination mail address is judged to be the address of the mailing list, automatically extracts the at least one mail address [col 3, lines 61-col 4, lines 11; and col 4, lines 48-56].

Hara does not specifically disclose

a second extracting unit which automatically extracts at least one mail address contained in a text of the E-mail received, wherein the second extracting unit, when the reply destination mail address is judged to be the address of the mailing list, automatically extracts the at least one mail address contained in a text of the E-mail received when the reply destination mail address is the address of the mailing list, and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list.

Weber discloses

a second extracting unit which extracts at least one mail address contained in a text of the E-mail received [Figure 5D; col 7, lines 32-46; and col 9, lines 60-64], wherein the second extracting unit, when the reply destination mail address is judged to be the address of the mailing list, automatically extracts the at least one mail address contained in a text of the E-mail received

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when the reply destination mail address is the address of the mailing list [i.e. if the IDP indicates third party addressing, then the system automatically updates the IDP with the third party addresses] [86, Figure 6; and col 5, lines 18-23], and does not extract any mail address contained in the text of the E-mail received when the reply destination mail address is not the address of the mailing list [i.e. if the IDP does not indicate third party addressing] [84, Figure 6; and col 5, lines 4-18].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Weber because Weber's teaching would allow to reply to destination correctly without error.

15. As per claim 4, Hara discloses a storage unit including a mail address book by which whether or not the reply destination mail address extracted from the mail header of the E-mail received is the address of the mailing list, can be judged [col 1, lines 10-20 and lines 29-37].

16. As per claims 7, 8, and 10, they are method claimed of claims 1, 2, and 4, they are rejected for similar reasons as stated above in claims 1, 2, and 4.

17. As per claims 13, 14, 16, they are program product claimed of claims 1, 2, 4, they are rejected for similar reasons as stated above in claims 1, 2, 4.

18. As per claim 19, it is rejected for similar reasons as stated above in claims 1 and 4.

19. Claims 5, 6, 11, 12, 17 and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara [US Patent No 5,938,725], in view of Weber et al. [US Patent No 5,878,230], and further in view of Meister et al. [US Patent No 6,671,718].

20. As per claim 5, Hara and Weber do not specifically disclose a processing unit which stores, if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address. Meister discloses a processing unit which stores, if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address [i.e. add complete address to the alert list if no alias] [134, Figure 5; and col 4, lines 55-col 5, lines 17]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara, Weber and Meister because Meister's teaching would allow to identify all the addresses of an E-mail for further processing.

21. As per claim 6, Hara and Weber do not specifically disclose a display unit which displays, when visibly displaying all the extracted mail addresses as the reply destination candidates, the name of the mail address extracted from the text of the received E-mail and unregistered in the mail address book as the name unknown in the format of corresponding to the mail address. Meister discloses a display unit which displays, when visibly displaying all the

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extracted mail addresses as the reply destination candidates, the name of the mail address extracted from the text of the received E-mail and unregistered in the mail address book as the name unknown in the format of corresponding to the mail address [i.e. determining alias existence] [130, 134, Figure 5; and col 4, lines 55-col 5, lines 16]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara, Weber and Meister because Meister's teaching of display unit would allow to alert user to the addresses of an e-mail message before it is sent [Meister, col 2, lines 6-19].

22. As per claim 11, it is method claimed of claim 5, it is rejected for similar reasons as stated above in claim 5.

23. As per claim 12, it is method claimed of claim 6, it is rejected for similar reasons as stated above in claim 6.

24. As per claim 17, Meister discloses storing, if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address [i.e. local electronic address book] [col 4, lines 55-col 5, lines 5].

25. As per claim 18, it is program product claimed of claim 6, it is rejected for similar reasons as stated above in claim 6.

26. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Follansbee John can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen
Examiner
Art Unit 2154


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
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